

**UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE COMMISSIONER OF PATENTS AND TRADEMARKS**

In re)	
)	Decision on
)	Petition for Regrade
)	Under 37 C.F.R. § 10.7(c)
_____)	

MEMORANDUM AND ORDER

(Petitioner) petitions for regrading her answers to questions 1, 2, 10, 22, 25, 31, 34 and 39 of the morning section of the Registration Examination held on August 26, 1998. The petition is denied.

BACKGROUND

An applicant for registration to practice before the Patent and Trademark Office (PTO) in patent cases must achieve a passing grade of 70 in both the morning and afternoon sections of the Registration Examination. Petitioner scored 62 on the morning section. On December 23, 1998, Petitioner requested regrading of eight two-point questions on the morning section, arguing that the model answers were incorrect.

As indicated in the instructions for requesting regrading of the Examination, in order to expedite a petitioner's appeal rights, all regrade requests have been considered in the first instance by the Commissioner.

OPINION

Under 37 C.F.R. § 10.7(c), Petitioner must establish any errors that occurred in the grading of the examination. The directions state: "No points will be awarded for incorrect answers or unanswered questions." The burden is on petitioners to show that

their chosen answers are the most correct answers. Petitioner has failed to meet this burden.

The directions to the morning section state in part:

Do not assume any additional facts not presented in the questions. When answering each question, unless otherwise stated, assume that you are a registered patent practitioner. Any reference to a practitioner is a reference to a registered patent practitioner. The most correct answer is the policy, practice, and procedure which must, shall, or should be followed in accordance with the U.S. patent statutes, the PTO rules of practice and procedure, the Manual of Patent Examining Procedure (MPEP), and the Patent Cooperation Treaty (PCT) articles and rules, unless modified by a subsequent court decision or a notice in the *Official Gazette*. There is only one most correct answer for each question. Where choices (A) through (D) are correct and choice (E) is "All of the above," the last choice (E) will be the most correct answer and the only answer which will be accepted. Where two or more choices are correct, the most correct answer is the answer which refers to each and every one of the correct choices. Where a question includes a statement with one or more blanks or ends with a colon, select the answer from the choices given to complete the statement which would make the statement *true*. Unless otherwise explicitly stated, all references to patents or applications are to be understood as being U.S. patents or regular (non-provisional) utility applications for utility inventions only, as opposed to plant or design applications for plant and design inventions. Where the terms "USPTO," "PTO," or "Office" are used in this examination, they mean the U.S. Patent and Trademark Office.

Petitioner has presented various arguments attacking the validity of the model answers. All of Petitioner's arguments have been considered, but lack merit. For the following reasons, no points will be added to Petitioner's score for the morning section of the Examination.

Question 1 reads as follows:

1. As patent counsel for the National Pharmaceutical Company (NPC), you prepared and filed in the PTO a patent application for an improved medication for treating osteomyelitis, an infectious inflammatory bone disease. The application listed John Jones, an NPC research biochemist who is obligated by an employment contract to assign all inventions to NPC, as the sole inventor. The specification referenced a prior art medication containing an effective amount of an organic compound having a cyclopentadiene ring structure containing a metal ion held by coordination bonds used in the treatment of osteomyelitis, and noted that its use was often accompanied by nausea and muscle cramps. Comparative test data set forth in the specification revealed that the negative side effects of the use of the prior art medication could be essentially avoided by limiting the metal ion to a metal ion selected from the group consisting of osmium (atomic number 76), iridium (atomic number 77), platinum (atomic number 78), and gold (atomic number 79). Following several years of prosecution, the application issued as a patent on February 24, 1998, with the following single claim:

A medication for treating osteomyelitis containing an effective amount of an organic compound having a cyclopentadiene ring structure containing a metal ion held by coordination bonds, said metal ion being selected from the group consisting of osmium, iridium, platinum, and gold.

On February 10, 1998, Jones submitted an invention disclosure to you containing test data demonstrating that when iridium, platinum, or gold, as contrasted with osmium, is selected for the metal ion of the aforementioned organic compound, half as much organic compound is required to be effective in the medication for treating osteomyelitis. You then prepared and filed on February 23, 1998, a continuation-in-part application in the PTO on this discovery. In the first Office Action the primary examiner rejected the following claim on the ground of "statutory type" double patenting over the Jones patent based on 35 U.S.C. § 101:

A medication for treating osteomyelitis containing an effective amount of an organic compound having a cyclopentadiene ring structure containing a metal ion held by coordination bonds, said metal ion being selected from the group consisting of iridium, platinum, and gold.

Which of the following actions should overcome the examiner's rejection in accordance with proper PTO practice and procedure?

- (A) File a reply traversing the rejection and arguing that the same invention is not being claimed because the patent claim is broader than the rejected claim. Therefore, the patent claim can be infringed without infringing the rejected claim.
- (B) File an amendment rewriting the claim in accordance with 37 CFR § 1.121, and adding the corresponding atomic number immediately following the recitation of each metal ion.
- (C) File a terminal disclaimer under 37 CFR § 1.321.
- (D) File a declaration of prior invention under 37 CFR § 1.131.
- (E) File a reply traversing the rejection and arguing that 35 U.S.C. § 103(c), does not preclude patentability because "the subject matter and the claimed invention, were, at the time the invention was made, owned by the same person or subject to an obligation of assignment to the same person."

The correct answer is (A) and Petitioner selected answer (B). The question inquires which of five actions should overcome an examiner's rejection in accordance with proper PTO practice and procedure. Choice (A) is the most correct answer in view of 37 C.F.R. § 1.111(b) which reads "[t]he reply by the applicant . . . must . . . distinctly and specifically point[] out the supposed errors in the examiner's action and must reply to every ground of objection and rejection in the prior Office action." In *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970), the Court stated: "By 'same invention' we mean identical subject matter. Thus the invention defined by a claim reciting 'halogen' is not the *same* as that defined by a claim reciting 'chlorine,' because the former is broader than the latter . . . [a] good test, and probably the only objective test, for 'same invention,' is whether one of the claims could be literally infringed without literally infringing the other. If it could be, the claims do not define identically the same invention." 422 F.2d at 441, 164 USPQ at 621-22; see also MPEP § 804, Part II A. Thus, the rejection is improper which needs to be pointed out by the applicant, as choice (A) indicates.

Answer (B) is not the most correct answer because it contains no argument distinctly and specifically pointing out the supposed errors in the examiner's action, as required by 37 C.F.R. § 1.111(b), and the amendment therein is not fully responsive to the examiner's rejection, as required by MPEP § 714.02. Additionally, the amendment does not change the scope of the claim because including the corresponding atomic number does not alter the claimed matter. Accordingly, the amendment does not traverse the standing rejection.

Petitioner argues that the amendment narrows the claim and thereby overcomes the double patenting rejection. Contrary to Petitioner's position, the CIP claim is already narrower than the original claim without the recitation of the atomic numbers. What is missing from answer (B) is a reply that accords with 37 C.F.R. § 1.111(b) and MPEP § 714.02. Similarly, Petitioner's argument concerning the law on two-way obviousness type double patenting is also unpersuasive since that subject is not part of answer (B) and responding to the examiner's Office action. Accordingly, no error in grading has been shown.

Question 2 reads as follows:

2. Your client, Mr. Jones, asked you to prepare a patent application for his new pasta maker. The key features of the invention are the different types of dough which can be used and the shapes of the pasta which can be made. The completed application was filed on Monday, May 18, 1998. After filing the application, you conducted a prior art search and found a published article by another which was published on May 16, 1997. The published article discusses a pasta maker very similar to your client's pasta maker. In the course of your search, you also found a few patents, but none as pertinent as the article. You file all of the prior art in an Information Disclosure Statement on June 8, 1998. In your opinion, the article is the best available prior art. Assuming that this is true, under which of the following sections of Title 35 U.S.C., if any, would Mr. Jones not be entitled to a U.S. patent?

- (A) 102(a)
- (B) 102(b)
- (C) 102(d)
- (D) 102(e)
- (E) None of the above.

Choices (A) and (E) are correct answers. Petitioner selected answer (B). Both (A) and (E) are considered correct answers in light of the statement that the “published article discusses a pasta maker very similar to your client’s pasta maker.” As explained in MPEP § 706.02, “for anticipation under 35 U.S.C. 102, the reference must teach every aspect of the claimed invention either explicitly or impliedly.” The phrase “very similar” can be understood to mean that the published article explicitly or impliedly discloses every aspect of the claimed invention. Under this interpretation, (A) is correct because the published article is prior art under 35 U.S.C. § 102(a) (used to reject claims to an invention that “was known . . . by others in this country, or . . . described in a printed publication in this . . . country, before the invention thereof by the applicant for patent”).

The phrase “very similar” could also be taken to mean that the published article did not teach every aspect of the claimed invention as required for anticipation under 35 U.S.C. § 102. Based on this interpretation, answers (A), (B), (C), and (D) would be rendered incorrect because they are all based on sections of 35 U.S.C. § 102. Accordingly, answer (E) “[n]one of the above,” is also a correct answer.

Answer (B) is not a correct answer because of when the one year anniversary date occurs for the published article and when the patent application needs to be filed. “When the day, or the last day, for taking any action or paying any fee in the United States Patent and Trademark Office falls on Saturday, Sunday, or a federal holiday within the District of Columbia, the action may be taken or the fee paid, on the next succeeding

secular or business day.” 35 U.S.C. § 21(b). This statute modifies the one year or twelve month periods specified in other parts of Title 35 including 35 U.S.C. § 102(b). See MPEP §§ 706.02(a); 2133. Therefore, the article would be a reference under 35 U.S.C. § 102(a) and not under § 102(b), since May 16, 1998, falls on a Saturday. *Ex parte Olah*, 131 USPQ 41, 43 (Bd. App. 1960).

Petitioner argues that the question is defective because it does not state the date of the claimed invention. However, the application filing date is recited in the question which is the date used with respect to addressing whether a printed publication is prior art or not. In this case, since no earlier date has been given with respect to when the invention was made, the examiner may use as prior art a published article bearing a date prior to the application filing date. 35 U.S.C. §§ 102(a) and 103. As discussed above, the article may be considered prior art for both lack of novelty and obviousness purposes. Accordingly, no error in grading has been shown.

Question 10 reads as follows:

10. Sam Smart, a cabinet maker employed by Star Furniture Company, designed a unique armoire blending the ascetic style of Shakerism with the flamboyant style of Victorianism. Star officials were so impressed that they asked Patent Counsel to take immediate steps to obtain patent protection on the armoire. Patent Counsel filed a provisional utility application in the PTO on September 16, 1997, naming Sam Smart as the sole inventor. On March 20, 1998, Patent Counsel file nonprovisional utility and design applications in the PTO, each application claiming priority from the provisional utility application under 35 U.S.C. § 119(e)(1). In the first Office action in the design application, the examiner rejected the sole claim as unpatentable under 35 U.S.C. § 103 over a photograph of a gun cabinet appearing in a department store catalog published in October 1997. Which of the following actions accords with proper practice and procedure and is most likely to overcome the rejection?

- (A) Traverse the rejection on the ground that the photograph is not available as a reference because the inventors named in the provisional and nonprovisional applications are the same, the nonprovisional application was filed within 12 months of the provisional application, the nonprovisional application refers to the copending provisional application, and the provisional application antedates the publication date of the reference catalog.
- (B) Traverse the rejection on the ground that the photograph is not available as a reference because while the photograph depicts a gun cabinet of substantially the same appearance as the claimed design, the gun cabinet and the armoire are not from analogous arts.
- (C) Traverse the rejection on the ground that the design of the armoire is not obvious from the reference because an armoire functions essentially to hold clothes, whereas a gun cabinet functions essentially to hold rifles.
- (D) Traverse the rejection on the ground that the ornamentation of the armoire is not obvious from the reference since the ornamentation of the armoire is embossed on the armoire surface, whereas the ornamentation of the gun cabinet is impressed in the gun cabinet surface.
- (E) Traverse the rejection by submitting evidence of commercial success of the claimed design and arguing that the overall appearance and design, characteristics of the gun cabinet are basically different from the claimed design.

Answer (E) is the most correct answer and Petitioner selected answer (D).

Choice (E) is most correct because, as MPEP § 1504.03, Part I.D., recites:

“[s]econdary considerations, such as commercial success . . . are relevant to the evaluation of obviousness of a design claim just as in a utility claim.” *See also In re Rosen*, 673 F.2d 388, 390, 213 USPQ 347, 349 (CCPA 1982) (“In determining the patentability of a design [e.g., under 35 U.S.C. § 103], it is the overall appearance, the visual effect as a whole of the design, which must be taken into consideration”).

Answer (D) is an incorrect choice because the ornamentation must still be viewed from an obviousness perspective regardless of whether it is embossed on or impressed into the surface. The mere fact of how the design is placed on the article of manufacture,

i.e., embossing or impressing, does not create a distinction with respect to obviousness. *See In re Cornwall*, 230 F.2d 457, 459, 109 USPQ 57, 58 (CCPA 1956) (“It is well settled that patentability of a design cannot be based on elements which are concealed in the normal use of the device to which the design is applied”). Accordingly, Petitioner’s argument that answer (D) is a satisfactory response to the Office action is unpersuasive.

Petitioner also argues that answer (E) lacks an adequate showing of commercial success. However, of the answer choices, answer (E) is the most correct because there is evidence of commercial success in the stated facts and it is presented to the examiner with specific argument of nonobviousness. Contrary to Petitioner’s position, the answer did not have to detail the commercial success evidence to the point of evaluating it as part of the question. The evidence existed and the applicant submitted it. Petitioner’s argument is unpersuasive and no error in grading has been shown.

Question 22 reads as follows:

22. Prior art references may be combined to show obviousness of the claimed invention under 35 U.S.C. § 103. Which of the following most correctly completes the statement: “In establishing obviousness,

- (A) a suggestion to modify the art must be expressly stated in one of the references used to show obviousness.”
- (B) a suggestion to modify the art must be expressly stated in all the references used to show obviousness.”
- (C) a suggestion to modify the art may be inherently or implicitly taught in one of the references used to show obviousness.”
- (D) a suggestion to modify the art is unnecessary unless the patent applicant presents evidence or argument tending to show unobviousness.”
- (E) A suggestion to modify the art can come from recent nonanalogous prior art references.”

The most correct answer is choice (C) and Petitioner selected choice (A).

Choice (C) is the most correct answer because a suggestion to modify the art may be inherently or implicitly taught in a reference to show obviousness. *See, e.g., In re Napier*, 55 F.3d 610, 613, 34 USPQ2d 1782, 1784 (Fed. Cir. 1995); *In re Grasselli*, 713 F.2d 731, 739, 218 USPQ 769, 775 (Fed. Cir. 1983); MPEP § 2112.

Answer (A) is not correct because a suggestion to modify the art need not be expressly stated in a reference for the claimed invention to be obvious. *See, e.g., Napier*, 55 F.3d at 613, 34 USPQ2d at 1784. Petitioner argues that the question required examinees to assume facts not presented in the question such as the number of claims in the pending application. However, the question concerned the law of obviousness and did not relate to the number of claims in any pending application. Accordingly, it was not relevant to know a given number of claims in a particular pending application.

Petitioner also argues that it is impermissible to use the claimed invention as a template to piece together teachings in the prior art and thereby make a hindsight rejection. Answer (C), however, does not contain such a hindsight rejection. This argument is therefore unpersuasive, and in view of the above, no error in grading has been shown.

Question 25 reads as follows:

25. Claimed subject matter has been rejected under 35 U.S.C. § 103 over a combination of prior art references, which purport to render the claimed subject matter *prima facie* obvious. Which of the following rebuttals properly demonstrates in the given circumstances that the references could not render the claimed subject matter *prima facie* obvious, and thereby overcome the rejection?

- (A) Where the primary reference is a Russian patent certificate, the secondary reference is a U.S. patent, and a registered practitioner argues that *prima facie* obviousness has not been demonstrated because the assumption that the person of ordinary skill in the art would be familiar with all prior art references pertaining to a given art is in conflict with reality.
- (B) Where the claimed subject matter is a method for detecting and measuring minute quantities of nitrogen compounds, the primary reference teaches a method for detecting and measuring minute quantities of sulfur having – in addition to all the limitations of the claimed method – a solvent to collect the sample and stating that the presence of nitrogen in the sample will interfere with measuring sulfur quantities, a secondary reference teaching a method of detecting minute quantities of nitrogen in the atmosphere, and a registered practitioner argues that the references may not be properly combined to formulate a rejection of *prima facie* obviousness because there is nothing to suggest that they be combined since the primary reference seeks to avoid nitrogen.
- (C) Where neither the primary nor secondary reference explicitly states that its teachings may be combined with the teachings of the other reference, a registered practitioner should argue that the references may not be properly combined to formulate a rejection of *prima facie* obviousness absent an express suggestion in one prior art reference to look to another specific reference.
- (D) Where the claimed detergent uses sugar to enhance the compatibility of softeners with other components of the detergent, the primary reference teaches a detergent having all the claimed limitations except for the presence of sugar, and the secondary reference teaches using sugar as a filler or weighting agent in detergents having softeners, a registered practitioner should argue that the claimed detergent cannot be *prima facie* obvious unless one reference teaches using sugar for the same purpose it is used in the claimed detergent.

- (E) Where the claimed food additive uses YXY to sweeten food, the primary reference teaches food additive having all the claimed limitations except for using XY as a preservative, and the secondary reference teaches the equivalence of XY and YXY as preservatives in food, a registered practitioner should argue that to establish a *prima facie* case of obviousness there must be a suggestion from the prior art that the claimed invention will have the same or similar utility as the one newly discovered by applicant.

The correct answer is (B) and Petitioner selected answer (A). The question asks which of five rebuttals properly demonstrates in the given circumstances that references could not render the claimed subject matter *prima facie* obvious, and thereby overcome the rejection. The recited circumstances are that the claimed subject matter has been rejected under 35 U.S.C. § 103 over a combination of prior art references, which purport to render the claimed subject matter *prima facie* obvious.

Choice (B) is the most correct answer. *See In re Fine*, 837 F.2d 1071, 1074, 5 USPQ2d 1596, 1599 (Fed. Cir. 1988) (although rationale to combine references need not be expressly stated in the prior art, it is error to find obviousness where references “diverge from and teach away from the invention at hand”); *W. L. Gore & Assoc. v. Garlock, Inc.*, 721 F.2d 1540, 1550, 220 USPQ 303, 311 (Fed. Cir. 1983).

Answer (A) is incorrect because it misstates the law. That is, the hypothetical person of ordinary skill in the art is presumed to know all the prior art in a field. *See, e.g., In re Deminski*, 796 F.2d 436, 442, 230 USPQ 313, 315 (Fed. Cir. 1986). Petitioner argues that the phrase “a given art” in answer (A) means that the hypothetical person would be required to know all art in any field, even one outside the person’s field of endeavor. However, such a reading of the answer choice is unreasonable. The answer choice discusses prior art references and responding to an obviousness rejection. All that

is meant by the art is the field of the claimed invention. This argument by Petitioner is simply unpersuasive. Accordingly, no error in grading has been shown.

Question 31 reads as follows:

31. Which of the following utility statements, which correspond in scope to the subject matter sought to be patented, is sufficient to meet the requirements of 35 U.S.C. §§ 101 and 112, first paragraph?

- (A) The invention is a novel process for making certain steroids which, in turn, are known to be useful in the formation of A-nor steroids. There is nothing in the record of the application file showing that any "A-nor steroid" which might ultimately be produced from the claimed compounds would itself be a useful product.
- (B) The invention is a composition which is the cure for all cancer.
- (C) The invention is a novel composition using a new source of stannous tin for incorporation in dentifrices by which term is meant mouth washes, tooth pastes, tooth powders and chewing gums, i.e., compositions for introduction into the oral cavity as cleansing compositions.
- (D) The invention is a composition which prevents the process of aging.
- (E) The invention is a device that increases the efficiency of an engine from 35% to 110%.

The correct answer is (C) and Petitioner selected answer (E). Answer (C) is the correct choice because the statement in (C) is a sufficient disclosure of a specific utility. *In re Langer*, 503 F.2d 1380, 1381, 1391-93, 183 USPQ 288, 289, 296-98 (CCPA 1974) (recited the same invention as that in (C) which was held to sufficiently disclose a specific utility); see also MPEP § 2107.01(c)(i).

Answer (E) does not sufficiently describe utility because the device discussed therein is inoperable. That is, it could not operate at 110% because maximum efficiency for the engine is 100%. *See, e.g., Newman v. Quigg*, 877 F.2d 1575, 1582, 11 USPQ2d 1340, 1345 (Fed. Cir. 1989) (perpetual motion machine alleged to have more usable energy coming out of it than going into it was held to lack utility and an enabling

disclosure). Additionally, 110% efficiency does not meet the requirement in MPEP § 706.03(a)(1) that the “assertion would be considered credible by a person of ordinary skill in the art.”

Petitioner argues that *Langer* supports answer (E) as the correct choice.

However, *Langer* is inapposite and fails to support the argument because, as noted above, the claimed composition in *Langer* was directed to dentifrices, not a device for engines asserting a 110% efficiency rate, and the utility thereof was set forth specifically, as recited in choice (B). Petitioner has simply cited no authority showing that the statement in (E) is credible on its face. Accordingly, no grading error has been shown.

Question 34 reads as follows:

34. On November 6, 1997, the practitioner filed a complete patent application, filing fee, and declaration under 37 CFR § 1.63 identifying inventors A and B by their full names, and providing their residence, post office addresses, and citizenship. Inventors A and B did not assign, and were under no obligation to assign their rights in the invention to any other party. A primary examiner required restriction between the invention of Claims 1-5, and the invention of Claims 6-10. The practitioner elected the invention of Claims 1-5. The examiner withdrew Claims 6-10 from consideration. On July 15, 1998, the practitioner filed a reply to a first Office action dated May 8, 1998, which did not set a period for reply. In the reply, Claims 6-10 were canceled, and Claims 1 and 3 were amended by adding limitations supported by information disclosed, but unclaimed in the application. The limitations were substantially embraced by the statement of invention in the application. Claim 1 is an independent claim, and Claims 2-5 depend directly or indirectly from Claim 1. On August 1, 1998, inventors A and B then provided the practitioner with information clearly showing that Claims 1-5, as amended, were not the joint invention of A and B, and that such error arose without deceptive intent. Which of the following actions fulfills proper PTO practice and procedure for correcting inventorship?

- (A) Where the information shows that A is the sole inventor of Claims 1-5, as amended, the practitioner should file an amendment to name only A as the sole inventor of the invention set forth in Claims 1-5, together with a statement by the practitioner to correct the inventorship. The foregoing should be filed promptly, and preferably before the next Office action.
- (B) Where the information shows that A and C are joint inventors of Claims 1-5, as amended, the practitioner should file an amendment deleting B as an inventor, and adding C as a joint inventor. The amendment should be accompanied by a petition including a statement by B and C that the error in inventorship occurred without deceptive intent on their part, a statement identifying B as the named inventor who is being deleted and acknowledging that B's invention is no longer being claimed, and a statement by C that the amendment is necessitated by the amendment of the claims. An oath or declaration under 37 CFR § 1.63 by A and C should also accompany the amendment. The foregoing should be filed promptly, and preferably before the next Office action.
- (C) Where the information shows that A is the sole inventor of Claims 1-5, as amended, the practitioner should file a properly completed request on a separate paper for a continuation application as a continued prosecution application. The request names as inventor only A, and is accompanied by the proper filing fee, and a statement by the practitioner requesting the deletion of B as inventor inasmuch as B is not an inventor of the invention being claimed in the new application. The foregoing should be filed before an issue fee is paid in the prior application, or before the prior application is abandoned.
- (D) Where the information shows that A and C are joint inventors of Claims 1-5, as amended, the practitioner should file a properly completed request on a separate paper for a continuation application as a continued prosecution application. The request names as inventors A and C, and is accompanied by the proper filing fee, and a statement by the practitioner requesting the deletion of B as inventor inasmuch as B is not an inventor of the invention being claimed in the new application, and addition of C as an inventor. The request is accompanied by a new declaration under 37 CFR § 1.63 naming A and C as the inventors. The foregoing should be filed before an issue fee is paid in the prior application, or before the prior application is abandoned.
- (E) All of the above.

The correct answer is (C) and Petitioner selected answer (B). The question inquires which of four actions fulfills proper PTO practice and procedure for correcting inventorship. Choice (C) is the most correct answer because the procedure in (C) follows the practice set forth in 37 C.F.R. § 1.53(d), including subsection (d)(4). A newly executed oath or declaration is not needed inasmuch as none is required when a continuation application is filed under the continuing prosecution application procedure in § 1.53(d).

The procedure in answer (B) is incomplete because the petition fee has not been paid and the requirements of 37 C.F.R. §§ 1.48(a)(3) and 1.17(i) have therefore not been met. Petitioner even acknowledges that answer (B) omits the required fee, but argues that the practice set forth therein, albeit incomplete, is most correct. However, without submitting the required fee, the response set forth in (B) is insufficient and therefore not as proper as the response set forth in answer (C). Of all the choices, answer (C) is the most proper choice, notwithstanding Petitioner's argument concerning the expense involved in filing the continued prosecution application identified in answer (C). In view of the above, no error in grading has been shown.

Question 39 reads as follows:

39. The Jones patent application was filed in the PTO in January 1998. Jones conceived and reduced the claimed invention to practice in the United States. A claim in the application has been rejected under 35 U.S.C. § 102 as being unpatentable over a U.S. patent to Smith. Smith did not derive anything from Jones, or visa versa, and at no time were Smith and Jones obligated to assign their inventions to the same employer. In which of the following situations should a declaration by Jones under 37 CFR § 1.131 overcome the rejection in accordance with proper PTO practice and procedure?

- (A) The rejected claim is drawn to a genus. The Smith patent issued in March 1997, on an application filed in June 1993. The patent discloses, but does not claim, a single species of the genus claimed by Jones. The declaration shows completion in April 1993, of the same species disclosed by Smith.
- (B) The rejected claim is drawn to a species. The Smith patent issued in March 1997, on an application filed in June 1993. The patent discloses, but does not claim, the species claimed by Jones. The declaration shows completion in April 1993, of a different species.
- (C) The rejected claim is drawn to a genus. The Smith patent issued in March 1997, on an application filed in June 1993. The patent discloses, but does not claim, several species within the genus claimed by Jones. The declaration shows completion in April 1993, of a species different from the reference's species and the species within the scope of the claimed genus.
- (D) The rejected claim is drawn to a genus. The Smith patent issued in March 1996, on an application filed in June 1993. The patent discloses, but does not claim, several species within the genus claimed by Jones. The declaration shows completion in April 1993, of one or more of the species disclosed in the patent.
- (E) The rejected claim is drawn to a genus. The Smith patent issued in November 1997, on an application filed in June 1993, and the patent discloses and claims several species within the genus claimed by Jones. The declaration shows completion in April 1993, of each species claimed in the Smith patent.

The correct answer is (A) and Petitioner selected answer (B). The question asks in which of five situations involving a rejection of a claim in Jones' patent application should a declaration by Jones under 37 C.F.R. § 1.131 overcome the rejection in accordance with proper PTO practice and procedure. The facts are as follows: Jones' patent application was filed in the PTO in January 1998; he conceived and reduced the invention to practice in the U.S.; a claim in the application has been rejected under 35 U.S.C. § 102 over the Smith patent; Smith did not derive anything from Jones, or vice versa; and at no time were Smith or Jones obligated to assign their inventions to the same employer.

Choice (A) is the most correct answer. MPEP § 715.03 reads: “Where the claim under rejection recites a species and the reference discloses the claimed species, the rejection can be overcome under 37 CFR § 1.131 directly by showing prior completion of the claimed species See *In re Spiller*, 500 F.2d 1170, 182 USPQ 614 (CCPA 1974).”

Petitioner chose answer (B) which is incorrect. To overcome a reference indirectly, as in (B), a showing of prior completion of a different species should be coupled with a showing that the claimed species would have been an obvious modification of the species completed by Petitioner. *Spiller*, 500 F.2d at 1178, 182 USPQ at 620, *In re Clarke*, 148 USPQ 665, 670 (CCPA 1966); *In re Plumb*, 470 F.2d 1403, 1407, 176 USPQ 323, 326 (CCPA 1973); *In re Hostettler*, 356 F.2d 562, 148 USPQ 514 (CCPA 1966); MPEP § 715.03. Contrary to Petitioner’s argument that the declaration is sufficient, since it addresses a different species, it also required the above showing set forth by the foregoing case law.

Petitioner argues that the phrase “of a different species” is unclear in her choice, answer (B). Assuming arguendo, that would in fact make answer (B) an incorrect answer choice and one that should not result in any credit for an examinee. Petitioner further addresses case law on rejections concerning genus and species claims. However, Petitioner fails to show how any of her cited and discussed case law demonstrates error in the grading of her answer to this question. In view of the above, no error in grading has been shown.

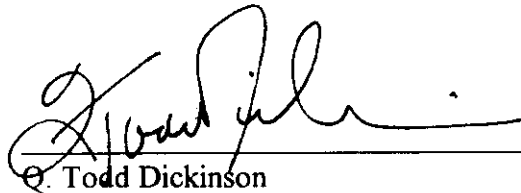
ORDER

For the reasons given above, no points have been added to Petitioner's score in the Morning Section of the Examination. Therefore, Petitioner's score remains at 62. This score is insufficient to pass the Morning Section of the Examination.

Upon consideration of the petition to the Commissioner for a regrade, it is ORDERED that the petition be denied.

This is a final agency action.

AUG 18 1999

A handwritten signature in black ink, appearing to read "O. Todd Dickinson", is written over a horizontal line.

O. Todd Dickinson
Acting Assistant Secretary of Commerce and
Acting Commissioner of Patents and Trademarks